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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/391,966 09/08/99 DITZIK

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WM02/0913

EXAMINER

URBAN, E

ART UNIT

PAPER NUMBER

2683

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/391,966

Applicant(s)

Ditzik

Examiner

Edward F. Urban

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Jun 28, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 14, 23, 24, 31, and 40-48 is/are pending in the applica

4a) Of the above, claim(s) 44-48 is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 14, 23, 24, 31, and 40-43 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Newly submitted claims 44-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented claims involve the technique of a computer display handset which has the capability to simultaneously run a plurality of communication modes while newly presented claims involve a specific technique for controlling wireless communication by formatting data to wireless communication protocols necessary for short distance.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44-48 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claim 14, 23-24, 31 and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen in view of Stein.

As to claim 14, Siitonen discloses a technique for controlling a computer-display handset, or hand held unit, which can be in the form of a PDA or cellular phone unit as recited in claims 23-24 (figures 2A, 2B) operated by a user in which an operating system is used for controlling the display as well as accepting user inputs and processing outputs. Also disclosed is the features of selecting from a plurality of computing and communication modes, such as wireless data, wireless voice and conventional computing functions as well as a plurality of program functions such as e-mail functions, voice communications and telephony functions (col. 2, line 15 - col. 3, line 48). Siitonen does not specifically disclose that these modes are run "roughly" simultaneously. However, since Siitonen et al. essentially discloses that the computer functions for the PDA are separate from the communication functions of the cellular telephone, then it would have been obvious to one having ordinary skill in the art to specifically run these functions simultaneously since the capability to do so is apparent and since one would like to

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receive a wireless call while the PDA is in operation. Also not disclosed by Siitonen et al. is the feature of the communication unit having the capability to communicate with a local communications base unit such as a notebook computer as recited in claim 40. However, this communication technique is common as shown by Stein in which he discloses such a communication link. Therefore, it would have been obvious to one having ordinary skill in the art to specifically allow the communication unit to communicate with a local base unit for the simple purpose of allowing the communication unit to conserve battery power by lowering its transmission power. Also disclosed by Siitonen et al. is the ability to communicate with other units in the communications mode as recited in claim 31 (col. 2, lines 15-29). As to the features of the communication unit being adapted to access the Internet, being equipped with hands free devices or having the ability to record audio or video content as recited in claims 41-43, such techniques are well known in the communication art and therefore would have been obvious to one having ordinary skill in the art to simply apply these well known features to the communication unit of Siitonen et al. and Stein for the simple purpose of allowing the communication unit to obtain a more user friendly features.

#### ***Response to Arguments***

5. Applicant's arguments filed 6/28/01 have been fully considered but they are not persuasive.

Applicant argues that Siitonen et al. teaches away from the technique of running both PDA functions and telephone functions simultaneously because the reference does not contain a

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speakerphone. However, the fact that Siitonen et al. does not contain a speakerphone cannot be interpreted to teach away from simultaneous operation. Although having a speakerphone in this environment would improve its operation, a communication unit without a speakerphone can still functionally be operational.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Urban whose telephone number is (703) 305-4385.

EFU

September 10, 2001

  
EDWARD F. URBAN  
PRIMARY EXAMINER